

Application S/ N 10/829,643
Amendment/Response Dated April 28, 2005
Reply to Office Action Mailed on February 17, 2005

identification indicia are comprised of conventionally recognized symbols.

Claim 17 (new): A financial institution issued debit/credit card comprising:

- a) a magnetic stripe card; and
- b) a combination of alphanumeric and non-alphanumeric

identification indicia displayed on said magnetic stripe card, wherein said non-alphanumeric identification indicia are comprised of conventionally recognized symbols.

Claim 18 (new): The financial institution issued debit/credit card of claim 17, wherein said magnetic stripe card is deleted and replaced with a smart chip card.

Claim 19 (new): The financial institution issued debit/credit card of claim 17, wherein said non-alphanumeric identification indicia are selected from the group consisting of a dollar sign, a cents sign, a question mark, an exclamation mark, and a lightning bolt symbol.

REMARKS/ARGUMENTS

A. In the Specification

Regarding the ABSTRACT OF THE DISCLOSURE

1. The Abstract has been amended to improve the flow of language and to conform with the proper language and format for an abstract. No new matter has been added.
2. Additionally, one paragraph has been amended in the specification to improve the flow of language and/or correct syntax. No new matter has been added.

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B. In the Claims

Claims 1-9 have been canceled. Claims 10-19 have been added.

Regarding the Claim Rejections under 35 U.S.C. 112

1. Claims 4-6 and 9 have been rejected under 35 U.S.C. 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 4-6 and 9 have been canceled.

Regarding the Claim Rejections under 35 U.S.C. 103(a)

1. Claims 1-5 have been rejected under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 2,012,346 to Meehan (“Meehan”). Claims 1-5 have been canceled. Claims 10-16 have been added. Applicant respectfully disagrees with this obviousness rejection in light of the changes made to the claims at issue herein.

Claims 1-5 were rejected over Meehan because of the theory cited in *In re Montgomery*, 102 USPQ 248 (CCPA 1954), that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. From this concept, it was further stated that once the concept of indicia has been disclosed, the selection of specific indicia is not separately patentable because the selection of specific indicia is an obvious matter of choice in design.

In the present invention, the novelty does not solely consist of the arrangement of printed matter. No claim is directed to a particular grouping or arrangement of identification indicia. Further, the present invention is not directed to a rearrangement of obvious identification indicia. The invention is directed to an improved government issued license plate containing new and unobvious identification indicia. The new identification indicia include non-alphanumerics in the form of conventionally recognized symbols. The license plate can either contain a combination of alphanumeric and non-alphanumeric identification indicia, or can solely contain

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non-alphanumeric identification indicia. The Meehan patent is directed to a license plate that utilizes letters and numbers for identification indicia. At no point in the Meehan patent is the use of non-alphanumeric symbols disclosed, claimed, or suggested. Because there is no attempt to claim printed matter, an arrangement of printed matter, or an arrangement of the identification indicia used in the Meehan patent, the present invention should not be rejected as an obvious matter of choice in design.

The novelty of the present invention does not solely consist of mere printed matter. As previously stated, no attempt is being made to patent the new identification indicia itself. Additionally, the identification indicia cannot be considered purely “printed matter” because of the fact that the identification indicia is not static, but varies from one license plate to another license plate.

Assuming the invention can be considered “merely a printed matter variation of the design of the reference”, it has been determined that this is not a valid reason for rejection, as printed matter may very well constitute structural limitations upon which patentability can be predicated. *In re Royka*, 490 F.2d 981 (CCPA 1974). Stated otherwise, printed matter, in an article of manufacture claim, can be given patentable weight. *In re Miller*, 57 C.C.P.A. 809, 813 (CCPA 1969). Thus, even if considered printed matter, the novel identification indicia would have to be taken into consideration along with all of the limitations contained in the claims to determine whether or not the invention as a whole is obvious in light of the Meehan patent. As previously mentioned however, there is no attempt to patent printed matter as no attempt is made to patent the printed indication indicia as such. Further, no attempt is made to patent a variation of the design of the reference because the use of non-alphanumerics was neither disclosed nor claimed in the Meehan patent.

As stated in *In re Gulack*, the critical question of patentability is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. 703 F.2d 1381, 1386 (Fed. Cir. 1983). A government issued license plate displaying new

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identification indicia provides several functions. Most importantly, the present invention increases the effectiveness and availability of government issued vehicle identification combinations. The function of a license plate is to identify vehicles. The function of the characters displayed on a license plate is to enable the identification of vehicles. The new identification indicia contained in the present invention functions to make the government issued license plate a more effective identifier of vehicles. This function can be seen in the ability of a pedestrian to identify vehicles involved in an automobile accident or at a crime scene. Pedestrians will be better able to identify at least a portion of a license plate because of the use of conventionally recognized non-alphanumeric symbols. For example, it is easier to remember a license plate containing the characters “NEED\$\$\$” or “\$\$@HOME” as opposed to a license that contains “G47P92W”. Thus, there is clearly a functional relationship between the identification indicia displayed on the license plate and the license plate itself.

The bare presence or absence of a specific functional relationship however, without further analysis, is not dispositive of obviousness. The additional step of comparing the functional relationship to the prior art is needed. *Ex Parte Johnston*, 2003 TTAB Lexis 609. The identification indicia claimed in the present invention was neither disclosed, claimed, nor suggested in the Meehan patent, nor any other patent issued to date. For this reason alone, the functional relationship between the identification indicia and the license plate substrate found in the present invention should not be considered obvious. When taken into consideration, other factors also lead to the conclusion that the present invention is not obvious.

The Meehan patent has existed for nearly 70 years. From the date of its grant until the date of the present invention by applicant, the standard use of non-alphanumeric identification indicia on government issued license plates had not occurred. Also, because of the increasing amount of new license plates being issued each year, the limit of the possible alphanumeric combinations is quickly being reached. There is a current significant need by state governments to increase the available combinations of license plate identification indicia. Additionally, there is a current and significant need by state governments to increase revenue. Both of these needs

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have been apparent for quite some time and are adequately provided for by the novel aspects of the present invention.

The present invention increases the number and availability of unique identification combinations on government issued license plates. The availability of numerous conventionally recognized symbols for use on government issued license plates expands the combination possibility beyond calculation. The present invention also meets the revenue increasing needs of state government by offering more options for license plate personalization. The availability of new identification indicia will attract more individuals to the concept of personalization, as well as provide those individuals who already have a personalized plate an opportunity to obtain another personalized plate containing representative symbols. Given that personalized license plates are more expensive than standard issue license plates, state governments stand to gain more revenue per license plate issuance if new identification indicia can be selected.

Furthermore, law enforcement officers acknowledge that front license plate compliance is a problem in many two plate states (states which require a license plate to be displayed both in the front and rear of the vehicle). Motorists with personalized plates are more likely to display both "vanity plates" because of image enhancement and the additional cost of these plates. Since the present invention encourages motorists to purchase personalized plates, the unappreciated advantage of front plate compliance is realized.

The present invention satisfies both current and long-felt needs of state governments. Evidence and potential satisfaction of these long-felt needs can be seen in a response letter received by Applicant from the Department of Finance of the State of California, attached hereto as Exhibit A. The letter states that information concerning the present invention will be forwarded to the appropriate authorities at the California Department of Motor Vehicles and the California Highway Patrol for an assessment of the invention's potential in California. This letter is but one example of the interest in the present invention that other states additionally possess. For all of the above mentioned reasons the present invention cannot be considered

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obvious. Therefore, in the context of the present invention, the answer to the critical question of patentability posed in *In re Gulack* must be that the present invention is not obvious and is patentable.

Furthermore, in *Montgomery*, the court found that there was an “abundance of suggestion in the prior art cited herein which is sufficient to justify a denial of patentability to the combination set forth in the appealed claim.” *Montgomery*, 41 C.C.P.A. 985, 987. Regarding the present invention, the Meehan patent was the only patent cited to in the rejection of claims 1-5. Nowhere in Meehan is there an “abundance of suggestion” of the novelty found in claims 1-5 to justify a denial of patentability. In a similar vein to *Montgomery*, courts have cautioned against the liberal use of printed matter rejections. In *In re Gulack*, the Court of Appeals for the Federal Circuit stated:

“A printed matter rejection under §103 stands on questionable legal and logical footing... Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art.” *Gulack*, 703 F.2d 1381, 1385 n.8. See also *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994).

Since the case of *Cincinnati Traction Co. v. Pope*, 210 F. 443 (6th Cir. 1913), courts have had difficulty drawing the dividing line between the printed matter rule and the functional relation to physical structure exception as stated in *In re Gulack*. This case, while falling close to the line, does not fall on the printed matter side. The present invention involves an organization of interrelated information on license plates that was neither claimed, disclosed, nor suggested in the Meehan patent. Even if the novelty of the present invention can be deemed to lack “structure” per se, the present invention is still patentable because of the functional relationship between the identification indicia and the license plate substrate. See *Lowry*, 32 F.3d 1579 (organized data in memory, while having no physical “structure” per se, held to be patentable). The present invention does not seek to claim solely identification indicia, a specific arrangement

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of identification indicia, or a variation of an arrangement of identification indicia already existing in the prior art. The present invention does however, seek to claim an unobvious functional relationship between the identification indicia and a license plate substrate. Thus, the claims of the present invention should not be rejected as being obvious over the Meehan reference alone.

Therefore, as amended, Applicant earnestly believes that new claims 10 through 16 are patentably distinguishable from Meehan. The teachings of Meehan alone do not in any way disclose, claim, teach, or remotely suggest the novel features of the present invention. In view of the above, Applicant submits that new independent claims 10, 13, 15, and 16 are novel and non-obvious over the cited reference and requests removal of this 103(a) rejection. In this respect, Applicant avers that all of the new dependent claims of new claims 10 and 13, currently as filed herein, are also novel and non-obvious over the prior art cited.

2. Claims 6-9 have been rejected under 35 U.S.C. 103(a), as being unpatentable over U.S. Patent No. 5,259,649 to Shomron (“Shomron”). Claims 6-9 have been canceled. Claims 17-19 have been added. Applicant respectfully disagrees with this obviousness rejection in light of the changes made to the claims at issue herein.

Claims 6-9 were rejected over Shomron because of the theory cited in *In re Montgomery*, 102 USPQ 248 (CCPA 1954), that patentable novelty cannot be principally predicated on mere printed matter and arrangements thereof, but must reside basically in physical structure. From this concept, it was further stated that once the concept of indicia has been disclosed, the selection of specific indicia is not separately patentable because the selection of specific indicia is an obvious matter of choice in design.

In the present invention, the novelty does not solely consist of the arrangement of printed matter. No claim is directed to a particular grouping or arrangement of identification indicia. Further, the present invention is not directed to a rearrangement of obvious identification indicia. The invention is directed to an improved financial institution debit/credit card containing new

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and unobvious identification indicia. The new identification indicia include non-alphanumerics in the form of conventionally recognized symbols. The debit/credit card can either contain a combination of alphanumeric and non-alphanumeric identification indicia, or can solely contain non-alphanumeric identification indicia. The Shomron patent is directed to a credit card that utilizes letters and numbers for identification indicia. At no point in the Shomron patent is the use of non-alphanumeric symbols disclosed, claimed, or suggested. Because there is no attempt to claim printed matter, an arrangement of printed matter, or an arrangement of the identification indicia used in the Shomron patent, the present invention should not be rejected as an obvious matter of choice in design.

The novelty in the present invention does not solely consist of mere printed matter. As previously stated, no attempt is being made to patent the new identification indicia itself. Additionally, the identification indicia cannot be considered purely “printed matter” because of the fact that the identification indicia is not static, but varies from one debit/credit card to another debit/credit card.

Assuming the invention can be considered “merely a printed matter variation of the design of the reference”, it has been determined that this is not a valid reason for rejection, as printed matter may very well constitute structural limitations upon which patentability can be predicated. *In re Royka*, 490 F.2d 981 (CCPA 1974). Stated otherwise, printed matter, in an article of manufacture claim, can be given patentable weight. *In re Miller*, 57 C.C.P.A. 809, 813 (CCPA 1969). Thus, even if considered printed matter, the novel identification indicia would have to be taken into consideration along with all of the limitations contained in the claims to determine whether or not the invention as a whole is obvious in light of the Shomron patent. As previously mentioned however, there is no attempt to patent printed matter as no attempt is made to patent the printed indication indicia as such. Further, no attempt is made to patent a variation of the design of the reference because the use of non-alphanumerics was neither disclosed nor claimed in the Shomron patent.

As stated in *In re Gulack*, the critical question of patentability is whether there exists any new and unobvious functional relationship between the printed matter and the substrate. 703 F.2d 1381, 1386 (Fed. Cir. 1983). A financial institution issued debit/credit card displaying new identification indicia provides several functions. Most importantly, the present invention increases the effectiveness and availability of financial institution debit/credit card identification combinations. A primary function of a debit/credit card is to allow for the safe storage of identification information. The function of the characters displayed on a financial institution issued debit/credit card is to enable the identification of a user's account. The new identification indicia contained in the present invention function to make the financial institution issued debit/credit card more effective in storing identification information of users. Another critical function of identification indicia is to decrease the likelihood of identity theft and credit card duplication. An increased number of identification indicia available for use on a financial institution issued debit/credit card makes it more difficult for a criminal to steal a customer's information, as the possible combination of account numbers is substantially increased. Thus, there clearly exists a functional relationship between the identification indicia displayed on the debit/credit card and the debit/credit card itself.

The bare presence or absence of a specific functional relationship however, without further analysis, is not dispositive of obviousness. The additional step of comparing the functional relationship to the prior art is needed. *Ex Parte Johnston*, 2003 TTAB Lexis 609. The identification indicia claimed in the present invention was neither disclosed, claimed, nor suggested in the Shomron patent, nor any other patent issued to date. For this reason alone, the functional relationship between the identification indicia and the debit/credit card found in the present invention should not be considered obvious. When taken into consideration, other factors also lead to the conclusion that the present invention is not obvious.

Credit cards have existed for several decades. Debit cards have also been in existence for nearly a decade. Both before and after the grant of the Shomron patent, use of non-alphanumeric identification indicia on financial institution issued debit/credit cards has not occurred. Also,

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because of the increasing amount of new debit/credit cards being issued by financial institutions each year, the limit of the possible alphanumeric combinations is quickly being reached.

The present invention increases the number and availability of unique identification combinations on financial institution issued debit/credit cards. The availability of numerous conventionally recognized symbols for use on debit/credit cards expands the combination possibility beyond calculation. Because the present invention satisfies the need for more identification combinations, the invention stands to be a commercial success when implemented. For all of the above mentioned reasons, the novelty of present invention cannot be considered obvious. Therefore, in the context of the present invention, the answer to the critical question of patentability posed in *In re Gulack* must be that the present invention is not obvious and is patentable.

Furthermore, in *Montgomery*, the court found that there was an “abundance of suggestion in the prior art cited herein which is sufficient to justify a denial of patentability to the combination set forth in the appealed claim.” *Montgomery*, 41 C.C.P.A. 985, 987. Regarding the present invention, the Shomron patent was the only patent cited to in the rejection of claims 6-9. No where in Shomron is there an “abundance of suggestion” of the novelty found in claims 6-9 to justify a denial of patentability. In a similar vein to *Montgomery*, courts have cautioned against the liberal use of printed matter rejections. In *In re Gulack*, the Court of Appeals for the Federal Circuit stated:

“A printed matter rejection under §103 stands on questionable legal and logical footing... Standing alone, the description of an element of the invention as printed matter tells nothing about the differences between the invention and the prior art or about whether that invention was suggested by the prior art.” *Gulack*, 703 F.2d 1381, 1385 n.8. See also *In re Lowry*, 32 F.3d 1579, 1582-83 (Fed. Cir. 1994).

Since the case of *Cincinnati Traction Co. v. Pope*, 210 F. 443 (6th Cir. 1913), courts have had difficulty drawing the dividing line between the printed matter rule and the functional

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relation to physical structure exception as stated in *In re Gulack*. This case, while falling close to the line, does not fall on the printed matter side. The present invention involves an organization of interrelated information on debit/credit cards that was neither claimed, disclosed, nor suggested in the Shomron patent. Even if the novelty of the present invention lacks "structure" per se, the present invention is still patentable because of the functional relationship between the identification indicia and a debit/credit card substrate. See *Lowry*, 32 F.3d 1579 (organized data in memory, while having no physical "structure" per se, held to be patentable). The present invention does not seek to claim solely identification indicia, a specific arrangement of identification indicia, or a variation of an arrangement of identification indicia already existing in the prior art. The present invention does however, seek to claim an unobvious functional relationship between the identification indicia and a debit/credit card substrate. Thus, the present invention should not be rejected as obvious over Shomron.

Therefore, as amended, Applicant earnestly believes that claims 17 through 19 are patentably distinguishable from Shomron. The teachings of Shomron alone do not in any way disclose, claim, teach, suggest or intimate the novel features of the present invention. In view of the above, Applicant submits that independent claim 17 is novel and non-obvious over the cited reference and requests removal of this 103(a) rejection. In this respect, Applicant avers that all of the dependent claims of claim 17, currently as filed herein, are also novel and non-obvious over the prior art cited.

Applicant acknowledges the references cited and not relied upon.

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CONCLUSION

All of the objections and rejections raised by the Examiner have been addressed by Applicant. Attorney for Applicant has carefully reviewed each one of the cited references, namely the Meehan and Shomron patents, and believes that the new claims presently on file in the subject application are patentably distinguishable with respect to the prior art, either taken alone or in combination with one another. In view of the amendments to the disclosure and the remarks submitted herein, Applicant submits that all of the new claims of record are in condition for allowance and respectfully requests that a Notice of Allowance be issued in this case in due course.

If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this application to allowance, the Examiner is invited to contact the undersigned, attorney of record in this case, Richard D. Clarke, Esq., at one of the listed below numbers or at his below listed e-mail address.

Dated: April 28, 2005

Respectfully submitted,
LAW OFFICE OF RICHARD D. CLARKE

By:



Richard D. Clarke
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October 18, 2004

Robert A. Gall, President
VIFLX Corporation
5000 Songbird Way
Parker, Colorado 80134

Dear Mr. Gall:

Thank you for the information you provided regarding the Vinyl Identification Plate and its potential uses in California. As you point out, State agencies are challenged to bring forward innovative approaches to address the State's budget situation and your product may help in that effort. Therefore, I will forward the information to both the Department of Motor Vehicles and the California Highway Patrol so that they can assess the product and its potential use in California.

Should you have any further information you wish to provide or any questions regarding this matter, please call Elliott Mandell, Principal Program Budget Analyst, at (916) 322-2263.

Sincerely,

MICHAEL C. GENEST
Chief Deputy Director